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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,461	10/07/2003	Kota Nozue	17100	4524

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EXAMINER

FLANAGAN, BEVERLY MEINDL

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 06/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/680,461

Applicant(s)

NOZUE, KOTA

Examiner

Beverly M. Flanagan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

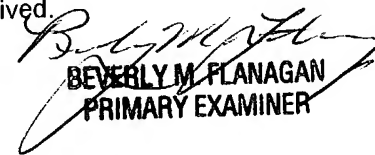
Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


BEVERLY M. FLANAGAN
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/7/03 & 1/16/04.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Objections

Claim 1 is objected to because of the following informalities: In claim 1, line 3, "lumer" should be --lumen--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by
Ishikawa et al. (U.S. Patent No. 6,306,081)

The applied reference has a common assignee with the instant application.
Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome

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either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

In regard to claim 1, Ishikawa et al. teach a hood 1 for an endoscope having a balloon 10 that expands to form a hood area 12 (see Figures 1 and 3). Figure 3 shows that hood area 12 protrudes in the direction of the observational field of view of the endoscope and has a shape which is not included within the range of the observational field of view. Ishikawa et al. Teach that the balloon 10 is formed from a material that under an application of external force when a forward end of the balloon 10 is pushed against a mucous membrane, it stays expanded, but deforms (see Figures 5 and 6 and col. 3, lines 25-32). Accordingly, Ishikawa et al. teach the use of an elastically deformable material, such as polyethyleneterephthalate, so that balloon 10 constitutes an elastically deformable soft component (see col. 3, lines 25-32). Figure 5 and 6 demonstrate that when balloon 10 is deformed by an external force, the deformed portion enters into the range of the observational field of view of the endoscope. **In regard to claims 2 and 3**, see Figures 1 and 3 and col. 2, lines 45-67 which discusses that the hood 1 is detachably mounted to the endoscope, but the joining member 4 ensures that it is also integral with the endoscope. Furthermore, it has been held that the term "integral" is sufficiently broad to embrace constructions united by such means as fastening and welding. *In re Hotte*, 177 USPQ 326, 328 (CCPA 1973). **In regard to claims 4-6**, Figures 5 and 6 of Ishikawa et al. demonstrate that the balloon 10 deforms by external forces of about 0/29 MPa or less. Furthermore, as the device of Ishkawa et

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al. contemplates deformation in the presence of external forces and provides the structure necessary to impart such deformation, it is inherently capable of performing the recited deformation. **In regard to claims 7-12**, Figure 3 shows that balloon 10 is comprised of a thin-walled portion that has a thickness smaller than the base end side of the hood 1, as constituted by mount member 3 and cylindrical section 6. **In regard to claims 13-18**, Figures 5 and 6 show that the thin-walled portion of balloon 10, when deformed, enters into the range of the observational field of view of the endoscope.

Claims 1-18 are rejected under 35 U.S.C. 102(a) as being anticipated by Yasuta (Japanese Publication No. 2003-245244, filing date 2/25/02).

In regard to claims 1-18, Yasuta teaches a hood member 20 for an endoscope formed from a soft and elastic material with a protruded part 21 having projected parts 24 such that the projected parts 24 are deformed by a force below 0.29 Mpa when force is applied from the tip of protruded part 21 (see the translated abstract and Figures 1-4). Figure 4 demonstrates that the protruded part 21 enters into the range of the observational field of view of the endoscope when deformed and Figure 7-10 show that the projected parts 24 have a thin-walled portion having a thickness that is smaller than than of the base end side.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant should note the following prior art references disclosing

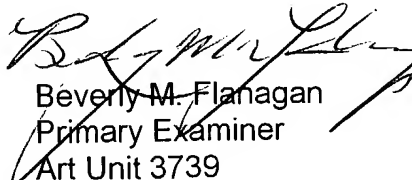
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hoods for endoscopes comprised of elastic materials that are capable of deforming under an external force: Ouchi, U.S. Patent No. 6,524,234; Ishibiki et al., U.S. Patent Application Publication No. 2003/0088154 and Suzuki et al., U.S. Patent Application Publication No. 2003/0225312.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beverly M. Flanagan whose telephone number is (703) 305-7202. The examiner can normally be reached on Mondays, Tuesdays and Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Beverly M. Flanagan
Primary Examiner
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